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EXAMINER

SERGEANT, RABON A

| ART UNIT | PAPER NUMBER |
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1711

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21

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 21

Application Number: 09/436,440

Filing Date: November 9, 1999

Appellant(s): Sanderson et al.

MAILED

SEP 10 2002

GROUP 1700

Stephen T. Sullivan

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 6, 2002.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The second amendment after final, filed February 11, 2002, has been entered; an advisory action was mailed to appellants on June 6, 2002.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. However, the 35 U.S.C. 103 rejection of claims 5, 6, 33, 37, 38, and 41 over Wardle ('613) in view of Oertel has been withdrawn. Please see the prior art rejection for further discussion. Accordingly, the Oertel reference is no longer being relied upon.

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(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4, 7-11, 34-36, 39, and 40 (grouping I), claims 5 and 37 (grouping II), claims 6 and 38 (grouping III), and claims 33 and 41 (grouping IV) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U. S. 4,806,613

Wardle

2-1989

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the A block containing segment and B block containing segment are mutually exclusive, since both segments may be crystalline below -20°C or amorphous above

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60°C. Despite appellants' argument, at temperatures beyond the recited extremes, the requirements of each segment can be satisfied by a single segment. Also, there is no requirement that the claim is operable only within the endpoints of the two temperature extremes.

Furthermore, despite appellants' arguments, the examiner's interpretation is reasonable in view of the claim language.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 33-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/436,360. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to polyisocyanate based elastomers derived from equivalent reactants. Despite appellants' response, the term, "difunctional oligomer", is fully encompassed by the difunctional linking compound of the copending application. In fact, the copending application clearly includes oligomers, including

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urethane oligomers derived from appellants' claimed reactants (instant claims 5, 6, 33, 37, 38, and 41), within the definition of possible linking compounds. See pages 15 and 16 of the copending application (the copending specification has been relied upon solely to determine the scope of compounds encompassed by the claimed "linking compound"). Therefore, it is not seen that any clear patentable distinction exists between the linking compounds of the respective sets of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-11, 34-36, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wardle ('613).

Wardle discloses the production of thermoplastic polyurethanes comprising A and B blocks, which correspond to those of appellants, wherein the blocks are linked by reaction of diisocyanates, such as 2,4-toluene diisocyanate, and linking compounds having isocyanate reactive groups. See abstract and columns 4-9, especially column 9, lines 1-17.

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Patentee is silent regarding the use of an oligomer as the linking compound; however, patentee does disclose that there is no limitation on the size of the linking compound. In the absence of a size requirement, the position is taken that one would have been motivated to utilize any size linking compound, including an oligomeric compound, so as to arrive at the instant invention.

In view of appellants' arguments and the comparative example on page 22 of the specification, the prior art rejection has been withdrawn with respect to the claims specifying that the oligomer is a urethane glycol or an oligomer derived from the reaction of a polyisocyanate and a polyol.

(11) Response to Argument


Appellants' arguments have been addressed with the ***Grounds of Rejection***.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

R. Sargent
September 9, 2002


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